

REMARKS

Claim 1 remains cancelled. Claims 4 to 6; 9 to 12; 14; 15; 17; 18; 21 to 23; and 26 to 28 have been canceled by this amendment. Claims 2; 7; 8; and 20 have been amended. New claims 29 to 36 are presented.

Claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25; and 29 to 36 remain in the application, for a total of eighteen claims. Of these, claims 2 and 32 are independent system claims.

Reexamination and reconsideration are respectfully requested in view of the amendments and the remarks that follow.

The Applicant acknowledges the Examiner's rejection of the claims as submitted by Preliminary Amendment under the judicially created doctrine of obviousness double patenting. Because these claims have been amended and newly submitted claims are still undergoing prosecution, Applicant respectfully seeks to postpone consideration of any terminal disclaimer until the nature and scope of allowable subject matter have been indicated. Applicant will proceed with prosecution and address the other grounds for rejection, subject to any double patenting rejection that the Examiner may maintain at the close of prosecution.

Claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25 stand rejected under 35 U.S.C. § 103(a) based upon Scholten et al (US 5,108,404) in view of Mikhail (US 5,718,707). Applicant believes the amended and new claims define subject matters not taught or suggested by Scholten and/or Mikhail.

Scholten does not teach or suggest an auxiliary tool, as defined in independent claims 2 and 32, that is sized and configured to be advanced through the interior bore of a nozzle (which itself passes through an access path established through soft tissue to bone), to urge filling material in a measured way from the nozzle. Mikhail is not compatible with Scholten and does not teach or suggest the incorporation of an auxiliary tool as defined in the claims into Scholten.

Regarding independent claims 2 and 32, Mikhail does not teach or suggest the use of an access path established through soft tissue into bone as defined in the claims. Mikhail hangs his dispenser on the proximal end of the femur in an open surgical procedure. Mikhail can not be fairly characterized as teaching or suggesting the use of a nozzle that passes through a soft tissue access path, much less an auxiliary tool that is advanced through that nozzle. Mikhail's dispenser is incompatible with any system that makes access to bone through soft tissue.

Further, regarding independent claim 2, Mikhail does not teach or suggest a nozzle that includes an interior bore that defines a fixed interior volume so that a measured volume of filling material can be delivered, as defined in claim 2. The interior volume of Mikhail's nozzle barrel 22 varies with advancement of the plunger 60. Mikhail cannot be fairly characterized as teaching or suggesting the advancement of an auxiliary tool through a bore that defines a fixed interior volume, so that a measured volume of filling material can be delivered, as defined in claim 2. Mikhail does not even contemplate the need to measure the volume of filling material delivered, and, as a result, Mikhail fills but does not measure the fill. Mikhail's dispenser is incompatible with a system that delivers a measured volume of filling material through soft tissue to a void formed in a bone.

Regarding new independent claim 32, Mikhail does not teach or suggest a nozzle that is manipulated independent of a cannula, and an auxiliary tool that is manipulated independent of the nozzle, as defined in claim 32. Mikhail does not use a cannula, and his auxiliary tool is integrated with the nozzle. Furthermore, Mikhail does not teach or suggest an auxiliary tool, that when fully advanced within the nozzle, substantially fully occupies the entire interior bore of the nozzle, as also defined in new claim 32. Mikhail's ejector member 34 occupies but a small end region of the nozzle barrel 22.

If anything, a person of ordinary skill knowing of Scholten and Mikhail (but not the subject matters defined in the claims), would perhaps have thought to couple Mikhail's dispenser at the proximal end of Scholten's nozzle. Without prior knowledge of the subject matters of the claims, a person of ordinary skill would not have thought to dismantle Mikhail's dispenser so it could be passed down a cannula. Without prior knowledge of the subject matters of the claims, a person of ordinary skill would not have disconnected Mikhail's ejector member 34 from the nozzle barrel 22, transformed the variable volume barrel into a nozzle with a fixed volume bore, and fitted the disconnected and transformed elements down a cannula.

For these reasons, Applicant respectfully asks the Examiner to withdraw his rejections based upon Scholten and Mikhail.

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Amendment A

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Applicant respectfully submits that claims 2; 3; 7; 8; 13; 16; 19; 20; 24; 25; and 29 to 36 stand in condition for allowance.

Respectfully Submitted,

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